

DOCKET NO. 2003.10.004.WS0
U.S. SERIAL NO. 10/696,502
PATENT

REMARKS

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Claims 1-19 were originally filed in the present application.

Claims 1-3, 5-8, 10-12 and 14-19 are pending in the present application.

Claims 1-3, 5-8, 10-12 and 14-19 were rejected in the November 6, 2007 Office Action.

No claims are amended herein.

Claims 1-3, 5-8, 10-12 and 14-19 remain in the present application.

The Applicants respectfully request reconsideration of the claims in light of the following arguments, which the Applicants make in order to more particularly define the issues for appeal.

Response to Arguments

In Section 1 of the November 6, 2007 Office Action, the Examiner asserts that the claims fail to recite features that are relied upon by the Applicants in distinguishing over the cited references, namely performing a hard handoff "while the MS remains solely within a shared coverage area." The Applicants respectfully submit that the Examiner appears to mischaracterize the language of the claims.

Claim 1 recites a base station controller that is operable to perform a hard handoff for a mobile station between a transition base transceiver station and a second base transceiver station "when the mobile station has reached a hard handoff region..., the hard handoff region...solely within a shared coverage region of the transition base transceiver station and the second base transceiver station." That is, the hard handoff is performed when the mobile station is in a hard

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Rejection Under 35 U.S.C. § 112, First Paragraph

In Section 3 of the November 6, 2007 Office Action, the Examiner rejected Claims 1, 3, 5-8, 10-12, and 14-19 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The claims contain subject matter that is not described in the specification in a manner enabling one skilled in the relevant art to make or use the claimed invention. This rejection is respectfully traversed.

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. MPEP §2164.01, p. 2100-186 & 187 (8th ed., rev. 5, August 2006). The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *Id.* A patent need not teach, and preferably omits, what is well known in the art. *Id.* The Patent Office has the initial burden of establishing a reasonable basis to question the enablement provided for the claimed invention. *Id.* at §2164.04, p2100-191. The minimal requirement for a proper enablement rejection is to give reasons for the uncertainty of the enablement. *Id.*

The Examiner asserts that support cannot be found in the Specification for the limitation "the hard handoff region...solely within a shared coverage region of the transition base transceiver station and the second base transceiver station." The Applicants respectfully direct the Examiner's attention to Figure 2A and paragraph [0045]. The hard handoff region 234 is solely within the shared

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coverage region 232 of the transition base transceiver station 224 and the second base transceiver station 244.

Accordingly, the Applicants respectfully request that the Examiner withdraw the § 112 rejection.

Rejection Under 35 U.S.C. § 103(a)

In Section 5 of the November 6, 2007 Office Action, the Examiner rejected Claims 1-3, 5-8, 10-12, and 14-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,011,971 to *Jolma* (hereafter, simply "Jolma") and further in view of U. S. Patent Application Publication No. (2003/0034947) to *Soliman* (hereafter, simply "Soliman").

When applying 35 U.S.C. 103, the claimed invention must be considered as a whole. See *MPEP* § 2141(II). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *MPEP* § 2141.02(I), citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Indeed, The Supreme Court has recently held,

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (U.S., 2007).

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The Applicants respectfully submit that the rejections of Claims 1, 6 and 11 over the combination of Jolma and Soliman is improper because the rejections address individual differences between the cited references and the claims, rather than considering the claims as a whole.

The Examiner acknowledges that Jolma fails to specifically disclose performing a hard handoff when a mobile station has reached a hard handoff region, the hard handoff region a portion of the second wireless network and solely within a shared coverage region of a transition base transceiver station and a second base transceiver station. However, the Examiner asserts that Soliman does describe such a hard handoff region.

Soliman describes a conventional wireless communication system wherein cells of a first telecommunications system and cells of a second telecommunications system overlap at the periphery of the two systems and a hard handoff is performed in the overlapping regions. *See Soliman, Figure 3, paragraph [0057]*. In contrast, Claim 1 recites a transition base transceiver station located in proximity to a second base transceiver station and a hard handoff region that is solely within a shared coverage region of the transition base transceiver station and the proximately located second base transceiver station.

In citing Soliman as describing a hard handoff region merely demonstrates that hard handoff regions was, independently, known in the prior art, rather than identifying why Soliman's description of hard handoffs between cells overlapping at their periphery would prompt a person of skill in the art to perform a hard handoff in a hard handoff region that is solely within a shared coverage region of co-located base transceiver stations, as recited in Claim 1.

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Furthermore, the Examiner asserts that Jolma "suggests" such a limitation by teaching base transceiver stations BTS11 and BTS21 are co-located and have a shared coverage region. In fact, Jolma teaches away from the limitations of Claim 1, describing a hard handoff that is performed not while the mobile station is in a region solely within the shared coverage region of BTS11 and BTS21, but rather after the mobile station reaches the region of overlap with the coverage area of BTS22.

For at least these reasons, Claim 1 is patentable over the combination of Jolma and Soliman. Claims 2, 3 and 5 depend from Claim 1 and include all its limitations. Therefore, Claims 2, 3 and 5 also are patentable over the cited references.

Independent Claims 6 and 11 recite limitations analogous to the novel and non-obvious limitations of Claim 1 discussed above and, therefore, also are patentable over the cited references. Claims 7, 8 and 10 depend from Claim 6, and Claims 12 and 14-19 depend from Claim 11, and include all the limitations of their respective base claims. As such, Claims 7, 8, 10, 12 and 14-19 also are patentable over the cited references.

The Applicants also disagree with the Examiner's rejections of Claims 1-3, 5-8, 10-12 and 14-19 based on additional misdescriptions and/or misapplications of the Jolma and Soliman references to at least some of Claims 1-3, 5-8, 10-12 and 14-19. However, the Applicants' arguments regarding those other shortcomings of the Jolma and Soliman references are moot in view of the Claim 1 arguments above. The Applicants reserve the right to dispute in future Office Action responses the appropriateness and the applications of the Jolma and Soliman references to the claims

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of the present application, including the right to dispute assertions made by the Examiner in the November 6, 2007 Office Action.

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SUMMARY

For the reasons given above, the Applicants respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS CARTER, P.C.

John T. Mockler

Date: January 31, 2008

John T. Mockler
Registration No. 39,775

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *jmockler@munckbutrus.com*

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